



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/607,246

06/25/2003

George Baran

6298/432

4973

7590

02/26/2007

Kent E. Genin  
Brinks Hofer Gilson & Lione  
P.O. Box 10395  
Chicago, IL 60610

EXAMINER

THANH, QUANG D

ART UNIT

PAPER NUMBER

3771

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

02/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/607,246

Applicant(s)

BARAN, GEORGE

Examiner

Quang D. Thanh

Art Unit

3771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 69-74 and 81-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 91-97 is/are allowed.
- 6) ☒ Claim(s) 69,70,73,74,99,101,102 and 104 is/are rejected.
- 7) ☒ Claim(s) 71,72,81-90,98,100,103 and 105-108 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Applicant is requested to update the status of Application No. 09/265,603 filed on 03/10/1999, which is now US Patent No. 6,729,334 in the cross-reference to related applications. Also, U.S. Application No. 08/787,013 appears to be incorrect and should be replaced with -- 08/787,813 --.

### *Terminal Disclaimer*

2. The terminal disclaimer filed on 11/10/06 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of US Patent No. 6,079,413 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 69-70, 73-74, 99, 101-102 and 104 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al. (5,031,613).

5. Re claims 69-70, 73-74, 99, Smith discloses a catheter (fig.1) for delivering an aerosol of medicine to a patient comprising: a catheter shaft 2 having a proximal end

Art Unit: 3771

and a distal end (fig. 1), the distal end of the catheter shaft curving away from a longitudinal axis of the catheter shaft (fig. 2); a lumen extending through the catheter shaft and adapted at a proximal end for receiving a medicine and communicating at the distal end with a distal medicine orifice from which the medicine is discharged in a direction toward the proximal end of the catheter shaft (fig. 1); and means for nebulizing the medicine discharged at the distal orifice into an aerosol plume of particles of the medicine (fig. 1); wherein the nebulizing means comprises at least one additional lumen of tube 4 (fig. 1), the at least one additional lumen configured to carry a gas and communicating with a distal gas orifice aligned to cooperate with the distal medicine orifice to generate the aerosol plume of particles of medicine; wherein the catheter shaft is configured for placement in the patient's lungs (col. 3, lines 27-29); wherein at least a portion of the catheter is constructed of a compliant material (col. 2, lines 16-18) wherein the medicine comprises a liquid (col. 3, lines 30-42).

6. Re claims 101-102 and 104, Smith discloses a catheter system (fig. 1) for delivering an aerosol to a patient comprising: a catheter shaft 2 having a proximal end and a distal end, the distal end for insertion into the patient (fig. 1); at least one lumen extending through the catheter shaft, the at least one lumen defining a distal orifice, the distal orifice located at the distal end of the catheter shaft (fig. 1); and wherein the distal orifice is aligned to generate a discharge of nebulized medicine in a direction toward the proximal end of the catheter shaft (fig. 1); wherein the medicine comprises a liquid (col. 3, lines 30-42); wherein the distal end of the catheter shaft comprises a curved shape (fig. 2).

Art Unit: 3771

***Allowable Subject Matter***

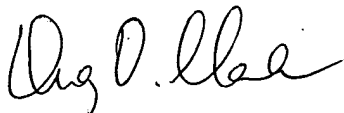
7. Claims 91-97 are allowed.
8. Claims 71-72, 98, 100, 103, 105-108, 81-90 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang D. Thanh whose telephone number is (571) 272-4982. The examiner can normally be reached on Monday-Thursday & alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The Central FAX phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for all communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Quang D. Thanh  
Primary Patent Examiner  
Art Unit 3771  
(571) 272-4982